

REMARKS

The applicant thanks the Examiner for the thorough examination of the application. No new matter is believed to be added to the application by this Reply.

Entry of Reply

Entry of this Reply under 37 C.F.R. 1.116 is respectfully requested because it places the application in condition for allowance. Alternately, entry is requested because it places the application in better form for appeal.

Status of the Claims

Claims 1-21 are pending in the application. Claim 21 was withdrawn from consideration by the Examiner. Claims 1-20 are rejected.

Claim Objections

The Examiner objects to claim 2 as being unclear. The Examiner asserts that the recitation "on the protective layer" is unclear and appears to contradict the base claim.

Claim 2 recites: "The liquid crystal display according to claim 1, wherein a contact hole connects said source electrode with a data line on the protective layer." This feature is clearly depicted in Figures 8 and 14, which show a data line 91 over a protective later 89, and the data line 91 connects to the source 83 through a contact hole 90a.

Also, paragraph 0069 at page 16 of the specification typically states, "Referring to Fig. 14, the data line 91 is formed on the protective layer 89."

Also, there is no recitation in claim 1 which claim 2 contradicts. Claim 1 recites "a protective layer covering said source electrode," which fully corresponds to the additional limitations of claim 2.

The Examiner's objection is thus obviated.

Rejections Based Upon The Applicant's Disclosure

Claims 1, 2, 7, 8 and 11 are rejected under 35 U.S.C. §103(a) as being obvious over Rho (U.S. Patent 6,057,896) in view of the Applicant's disclosure. The Examiner adds the teachings of Shimada (U.S. Patent 6,424,399) to the aforesaid rejection to reject claims 3, 4, 9 and 13-15. The Examiner adds

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the teachings of Jeong (U.S. Patent 6,137,551) to Rho and the Applicant's disclosure to reject claims 5, 10, 16 and 17. The Examiner adds the teachings of Shimada '325 (JP-03-141325) to Rho and the Applicant's disclosure to reject claims 6 and 18. The Examiner rejects claims 12, 19 and 20 over Rho in view of the Applicant's disclosure. Applicant respectfully traverses all of the aforesaid rejections.

In the Office Action the Examiner turns to the conventional art depicted in Figures 5 and 6D of the application and alleges that the Applicant has admitted these to be prior art. The utilization of the Applicant's disclosure without an admission of prior art is improper when the Applicant's disclosure represents the Applicants' own work. Riverwood International Corporation v. R.A. Jones & Co., Inc., 324 F.3d 1346, 66 U.S.P.Q.2d 1331 (C.A.F.C. 2003).

There is an important distinction between the situation where the inventor improves upon his own invention and the situation where he improves upon the invention of another. In the former situation, where the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission has knowledge of his own work . . . One's

own work may not be considered prior art in the absence of a statutory basis and a patentee should not be "punished" for being as inclusive as possible and referencing his own work . . . 324 F.3d at 1355.

In the Office Action, the Examiner turns to the Applicant's disclosure depicted in Figures 5 and 6D of the application and alleges that the Applicant has admitted these to be prior art. This disclosure helps to elucidate the problem that the invention solves: the reduction in aperture ratio that results from increasing the area of the capacitor electrode. However, this disclosure represents the Applicant's own work which cannot be utilized to allege prior art. As pointed out in Riverwood, a rejection must have a statutory basis.

Further, in In re Nomiya, the C.C.P.A. determined that even if there has been an admission of prior art, this admission of prior art would still not render an invention obvious if it points out the source of the problem that the invention solves.

It should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103. In re Antonson, 47 CCPA 740, 272 F.2d 948, 124 USPQ 132; In re Lennert, 50 CCPA 753, 309 F.2d 498, 135 USPQ 307. The court must be ever alert

not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings. In re Murray, 46 CCPA 905, 268 F.2d 226, 122 USPQ 364; In re Sporck, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360. The issue, then is whether the teachings of the prior art would, ***in and of themselves and without the benefits of the appellant's disclosure***, make the invention as a whole, obvious. In re Leonor, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20. (Emphasis in original) In re Nomiya 509 F.2d 566, 571, 184 U.S.P.Q. 607, 612 (C.C.P.A. 1975).

In this case there has been no admission of prior art. Even if one assumes *arguendo* that the subject matter discussed in the Background Art section and depicted in Figures 5 and 6D is prior art, this disclosure depicts the problem that the invention solves. These teachings therefore cannot be used to provide motivation to combine references.

If, as appellants claim, there is no evidence of record that a person of ordinary skill in the art at the time of the appellant's invention would have expected the problem . . . to exist at all, it is not proper to conclude that the invention which solves this problem, which is claimed as an improvement of the prior art device, would have been obvious to that hypothetical person of ordinary skill in the art. 184 U.S.P.Q. 612, 613.

Also, the Examiner has admitted the utilization of the Applicant's own disclosure to provide motivation to combine references. The Examiner at page 4, lines 21-23 states: "APA is

evidence that ordinary workers in the field of liquid crystals would have found the reason, suggestion and motivation to form the structures as illustrated in APA Figures 5 and 6D for increased capacitance to overcome the flicker phenomenon."

There is thus no motivation for one having ordinary skill in the art to combine the references of Rho, Shimada, Jeong or Shimada '325 with the Applicant's own disclosure. As a result, the claims are patentable because 1) the Applicant's disclosure is not usable to allege prior art, 2) there is no statutory basis to utilize the Applicant's own disclosure as prior art, and 3) there is no motivation to combine the references even if the Applicant's disclosure could be used. A *prima facie* case of obviousness has thus not been made.

These rejections are accordingly overcome and withdrawal thereof is respectfully requested.

Drawings

The Examiner has found to drawing figures to be acceptable in the Office Action mailed October 12, 2004.

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Foreign Priority

The Examiner has acknowledged foreign priority in the
Office Action mailed October 12, 2004.

CONCLUSION

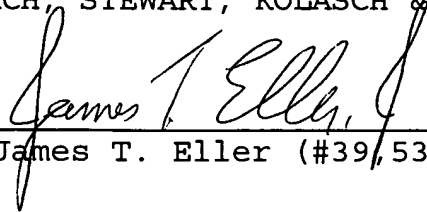
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D. (Reg. No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By


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